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EXAMINER

POON, K

ART UNIT

PAPER NUMBER

2724

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/991,855

Applicant(s)

Takahiro KII, et al.

Examiner

King Y. Poon

Group Art Unit

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☒ Responsive to communication(s) filed on Oct 4, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-25 is/are pending in the applicat

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-25 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peter et al..

Regarding claim 1: Peter et al teaches a method and system to process (manage) electronic message and reply (see abstract) having a storage mean to store data for reply (see#102 of fig.13), a control mean to process the accepted output data from a local user (#1 of fig.1) for a reply (see column 8 line 48-55), and a transmission mean for automatically transmitted the data (survey document reply data)back to a collation mean. (See column 8 line 53) Even though Peter does not call the transmission mean an output mean, it would have been obvious to one of ordinary skill in the art to know that a transmission mean is an output mean because transmission mean is used to outputting data from one source to another.

Regarding claim 2: Peter et al teaches to use a collation mean to monitor (manage) a plurality of replies by identifying (specifying) the survey document and its data. (See column 8 line 63-68) Peter also teaches to add the reply data (see column 5 line 32-34) and to manipulate the data and do a graphic plot (see column 4 line 25-27). However, Peter does not use the word

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totaling mean. It would have been obvious to one of ordinary skill in the art to know that by teaches to add is equivalent to a totaling mean because the function of a totaling mean is to add.

Regarding claim 3 and 4: Peter teaches that the control means in claim 1 is used to accepting an input by the respondent user in reply to the survey message manage the reply data by constructing a data base for it. (See column 8 line 48-57)

Regarding claim 5: Peter teaches to use E-mail as a form of communication between local and a remote user. (See column 8 line 20-30) Peter doesn't specify that the data can be text, still picture, speech sound and moving picture. But it would have been obvious to one of ordinary skill in the art to know that those data can be a text, still picture, speech sound and moving picture because it is very common for E-mail users to send all those data through E-mail in communication and it would not make sense if Peter chooses not to use all of the capacity of E-mail.

Regarding claim 6: Peter teaches use the control mean to produce a response document and automatically transmitted back to a collation mean. The word "automatically" includes causing the output means to output data for if the control mean cannot cause the output mean to output data, there is no way data can be automatically transmitted back.

Regarding claim 7: Peter et al teaches a method and system to process (manage) electronic message and reply (see abstract) including a client apparatus (#1 of fig.1) and a server apparatus (#7 of fig.1) with the clients' apparatus having a storage mean to store data for reply (see column line 55-57), a control mean to process the accepted output data from a local user (#1

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of fig.1) for a reply (see column 8 line 48-55), a transmission mean for automatically transmitted the data (survey document reply data)back to a collation mean. (See column 8 line 53) Even though Peter does not call the transmission mean an output mean or communication control mean, it would have been obvious to one of ordinary skill in the art to know that a transmission mean is an output and communication control mean because the transmission mean in Peter's invention is automatically outputting data ( the reply) from the client to the server through a collation mean (See fig.13) and it is performing the same function as the output mean and the communication control mean.

Regarding claim 8: Peter teaches to accept a reply (response) to the survey message in the control mean (see column 8 line 51-52) and also teaches to manage replies from the client in the server by loading the data base with answers, so that the answers are all conveniently presented in a database.

Regarding claim 9: Peter teaches a method and system having a client and a server apparatus with the server apparatus having a storage mean to store data (# 102 of fig. 13) and a transmission mean for transmitting the survey document data. (See column 2 line 62). Peter also teaches to use the client's apparatus to receive data from the server, (see column 8 line 45-46) to output the data for reply in a screen (see #7 of fig.1), to use a control mean to process the accepted output data from a local user (#1 of fig.1) for a reply (see column 8 line 48-55), and to automatically transmitted the data (survey document reply data)back to a collation mean. (See column 8 line 53) Even though Peter does not call the transmission mean a communication

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control mean, it would have been obvious to one of ordinary skill in the art to know that a transmission mean is a communication control mean because transmission mean is used to outputting data from one source to another and is doing the same function as the communication control mean in this claim.

Regarding claim 10: Peter teaches to use a control mean to manage the replies (response). (see column 8 line 50-55) in the client side and also teaches to receive replied data in the server side (see column 3 line 35-40 ) and store the result of the totaling mean (see discussion on claim 2) in a database (#102 of fig.13).

Regarding claims 11 and 12: see discussion on claim # 8.

Regarding claim 13: See discussion on claim # 9. In addition, Peter teaches that there could be more than one set of data for the client to reply (see column 5 line 55 -68) and the remote user can select any of those data to reply, store the data in a database, (see column 8 line 55-57) and transmit the selected reply to the server. The server can select a question for output to the client base on the type of client's answer. (Category of message)

Regarding claim 14: Peter teaches to manage a plurality of replies by creating a data base in the server side (see column 4 line 24-27) for a new set of data based on the replies and to transmit the data back to the client (see column 4 line 30-45) and the client can manage a plurality of other data for reply and transmit back to the server. This process can go on for a few cycles according to Peter, and many new sets of data from the previous reply can be formed.

Regarding claim 15 and 16: see discussion on claim # 8.

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Regarding claim 17-20: Peter teaches to use a recording medium readable by a computer to store the program code used for the execution of the method discussed in claim 1-16 (see column 10 line 30-35)

Regarding claims 21: Peter et al teaches a message system to process (manage) electronic message and reply (see abstract) having a storage mean to store a plurality of fixed form replies set (see bulletin board and column 3 line 1-13) a controller (the computer used as a bulletin board e.g. # 1 of fig. 1) for receiving a message from a host and allow a user to select a reply from a fix form reply set (see reply of # 4, 6, 8, 12 of fig. 6) and a transmission mean for automatically transmitted the data (survey document reply data) back to a collation mean. (See column 8 line 53) Even though Peter does not call the transmission mean an output device, it would have been obvious to one of ordinary skill in the art to know that a transmission mean is an output mean because transmission mean is used to outputting data from one source to another.

Regarding claim 22: Peter teaches that the controller selects a fix form reply set base on one or more predetermined answers input by a user. (Note: a group predetermined answers can be view as a category of message) (see column 5 line 54-67)

Regarding claim 23: Peter teaches to use E-mail as a form of communication between local and a remote user. (See column 8 line 20-30) Peter doesn't specify that the data can be a text, still picture, speech sound and moving picture. But it would have been obvious to one of ordinary skill in the art to know that those data can be a text, still picture, speech sound and moving picture because it is very common for E-mail users to send all those data through E-mail

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in communication and it would not make sense if Peter chooses not to use all of the capacity of E-mail.

Regarding claim 24: Peter et al teaches to use a collation mean to monitor (manage) a plurality of replies by identifying (specifying) the survey document and its data. (See column 8 line 63-68) Peter also teaches to manipulate the data and do a graphic plot (see column 4 line 25-27). The response data can be a frequency of response. (See half of the response is yes of column 4 line 34-36)

Regarding claim 25: Peter teaches to use a recording medium readable by a computer to store the program code used for the execution of the method discussed in claim 21. (see column 10 line 30-35)

### 3. REMARKS

Applicant's argument (claim 1) that "Peters does not contain a " storage means for storing data for a fixed form reply" has been considered. In reply, Peters has shown us a storage device. (See # 102 of fig. 13). Peter's invention can also be used on a "bulletin board" and not as an E-mail alone. (See column 3 line 5-13) A bullet board is a computer system (storage) equipped with one or more modems or other means of network access that serve as information and message-passing center for remote users. Users dial into a Bulletin board with their modems and post message to other bulletin board users in special areas to a particular topic, in a manner reminiscent of the posting of notes on a cork bulletin board.



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Applicant's argument that "claims 3 and 4 recite a "accepting an input of free form reply." Peter has no such corresponding feature." has been considered. In reply, Peter teaches that the control means in claim 1 is used to accepting an input by the respondent user in reply to the survey message manage the reply data by constructing a data base for it. (See column 8 line 48-57). In other words, the reply by the user is considered as an input of the free form reply.

Applicant's argument (claim 5) that "the examiner admits that" Peter doesn't specify that the data can be text, still picture, speech, sound and moving pictures." The examiner does state that it would have been obvious to one of ordinary skill in the art to know that such data can be sent via E-mail. However, the sending of data types such as, for example, speech, not merely as E-mail but as a fixed form reply is not disclosed by any of the prior art." has been considered. In reply, Peter teaches fixed form replies and sending the fixed form reply as a kind of data through E-mail. E-mail teaches that the kind of data that sent through E-mail can take the form as speech, still picture, sound, and moving picture. It is obvious that a user can choose to send the fixed form reply through E-mail in the form of speech, still picture, sound, and moving picture. The reason for doing so is to allow a user to use all of the capacity of E-mail.

Applicant's argument (claim 6) that "Peter teaches use the control means to produce a response document and automatically transmitted back to a collation means" This has nothing to do with causing the output means to output data for a fixed form reply of the kind which fits the content of the message." has been considered. In reply, the response that is produced is an answer (input) that a user input to the system for a fixed form reply of the kind that fits the

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content of the question (message). The control means then outputs the answers (data) to a collation mean.

Applicant's argument that "claim 8 recites a "free form reply" . . . Peters has no mechanism for allowing a free form reply" has been considered. In reply, please see the system fig. 13 that is used for free form replies to a survey.

Applicant's argument that "In addition, claim 9 recites that server apparatus comprises "communication control means for transmitting said data for a reply to the clients' apparatus." Again Peters does not have such a feature. In reply, Peter teaches a method and system having a client and a server apparatus with the server apparatus having a storage mean to store data (# 102 of fig. 13) and a transmission mean for transmitting the survey document data. (See column 2 line 62). Peter also teaches to use the client's apparatus to receive data from the server, (see column 8 line 45-46) to output the data for reply in a screen (see #7 of fig.1), to use a control mean to process the accepted output data from a local user (#1 of fig.1) for a reply (see column 8 line 48-55), and to automatically transmitted the data (survey document reply data) back to a collation mean. (See column 8 line 53) Even though Peter does not call the transmission mean a communication control mean, it would have been obvious to one of ordinary skill in the art to know that a transmission mean is a communication control mean because transmission mean is used to outputting data from one source to another and is doing the same function as the communication control mean in this claim.

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Applicant's argument that (claim 13) "Peters does not relate to selecting a fixed form reply based on the category of the message, and cannot render claim 13 obvious" has been considered. In reply, See discussion on claim # 9. In addition, Peter teaches that there could be more than one set of data for the client to reply (see column 5 line 55 -68) and the remote user can select any of those data to reply, store the data in a database, (see column 8 line 55-57) and transmit the selected reply to the server. The server can select a question for output to the client base on the type of client's answer. (Category of message)

Applicant's argument that " claim 14 recites, "the server apparatus comprises fixed form reply managing means . . . " and "the clients' apparatus comprises fixed form reply managing means . . . " again, as state above, Peters has no such equivalent" has been considered. In reply, Peter teaches to manage a plurality of replies by creating a data base in the server side (see column 4 line 24-27) for a new set of data based on the replies and to transmit the data back to the client (see column 4 line 30-45) and the client can manage a plurality of other data for reply and transmit back to the server.

Action is Final, Necessitated by Amendment

4. Applicant's amendment necessitated the new ground of rejection presented in this office action. Therefore, THIS ACTION IS MADE FINAL. See MPEP 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTHS shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to King Y. Poon whose telephone number is (703) 305-0892 or to Supervisor Mr. David Moore whose phone number is (703) 308-7452.



DAVID K. MOORE  
SUPERVISORY PATENT EXAMINER  
GROUP 2700

November 5, 1999